



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
D1W Apr-09

SAP / FINNEGAN, HENDERSON LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED

APR 08 2009

OFFICE OF PETITIONS

In re Application of :
Joerg Beringer :
Application Number: 10/649377 : ON PETITION
Filing Date: 08/27/2003 :
Attorney Docket Number: :
09282.0007.00000 :

This is a decision on the "PETITION TO RE-MAIL FINAL OFFICE ACTION AND RESTART PERIOD FOR RESPONSE," filed on October 2, 2008, which is treated as a petition under 37 CFR 1.181 to consider a reply as timely filed.

On April 30, 2008, a final Office action was mailed, setting a three (3)-month shortened statutory period for reply.

On October 2, 2008, the subject petition was filed.

On October 29, 2008 a Notice of Appeal and three (3) month extension of time were filed.

Petitioner asserts that the final Office action was never received. In support, petitioner has supplied a copy of the law firm's docket record and mail log. Petitioner has also provided a statement by registered patent practitioner C. Gregory Gramenopolous, stating that a USPTO mail search of the undersigned firm's mail log shows no entry that the Final Office Action was received. The mail log and docket report are referenced in the practitioner's statement.

A review of the record reveals no irregularity in the mailing of the final Office action mailed on April 30, 2008, and in the absence of any irregularity in the mailing, there is a strong presumption that the final Office action mailed on April 30, 2008, was properly mailed to the address of record. This presumption may be overcome by a showing that the final Office action mailed on April 30, 2008 was not in fact received.

MPEP 711.03(c) states, in pertinent part:

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted

as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

(emphasis added)

Accordingly, the showing of record is that the final Office action mailed on April 30, 2008, was never received. Therefore, the delay in filing a reply to the final Office action mailed on April 30, 2008, will be excused.

In view of the failure to receive the final Office action mailed on April 30, 2008, no extension of time is required for a timely reply. The extension of time fee will be credited to counsel's deposit account.

Receipt of the Notice of Appeal filed in response to the final Office action mailed on April 30, 2008 is acknowledged. As the Notice of Appeal constitutes a reply to the final Office action, it is unnecessary to remail the aforementioned Office action.

Therefore, the Office reminds applicant that the two (2)-month extendable period to file an appeal brief in compliance with 37 CFR 41.37, accompanied by the fee required by law, began to run on October 29, 2008, the date of filing the Notice of Appeal. The Office notes that "37 CFR 41.37(a) does not permit the brief to be filed within the time allowed for reply to the action from which the appeal was taken even if such time is later." *MPEP* 1205. "Once appellant timely files a notice of appeal in compliance with 37 CFR 41.31, the time period for reply set forth in the last Office action is tolled and is no longer relevant for the time period for filing an appeal brief." *Id.* **Therefore, applicant is required to submit an appeal brief on or before May 29, 2009, accompanied by a request for an extension of time for response within the fifth month and fee to avoid abandonment of this application.** In other words, applicant, himself, started the running of the two-month extendable period to file an appeal brief based upon the date applicant originally submitted the Notice of Appeal with the USPTO.

The petition is granted to the extent indicate above.

The application is being referred to Technology Center Art Unit 2445 for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

A handwritten signature in black ink, appearing to read "D Wood", is positioned above the typed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions